

## Remarks

### **The Amendments**

Claims 1-8, 15, 16, 17, 19, and 21 are canceled without prejudice herein as drawn to non-elected inventions according to the restriction requirement of October 13, 2006. Claim 9 has been amended to incorporate the limitations of claim 10. Applicants believe that claim 9 is allowable as originally presented; however, in order to advance prosecution, claim 9 is amended herein. Claim 10 has been canceled. The Office has indicated that claim 10 is objected to as being dependant upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim. Therefore, the amendment is made to place the application in condition for allowance and Applicants respectfully request its entry. No new matter is added by the amendment.

Amendments to the claims are made without prejudice and do not constitute amendments to overcome any prior art or other statutory rejections and are fully supported by the specification as filed. Additionally, these amendments are not an admission regarding the patentability of subject matter of the canceled or amended claims and should not be so construed. Applicant reserves the right to pursue the subject matter of the previously filed claims in this or in any other appropriate patent application.

### **Rejection of Claim 13 Under 35 U.S.C. §112, second paragraph**

Claim 13 stands rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite. Applicants respectfully traverse the rejection.

The Office asserts that claim 13 is vague because it appears to be for detection of an analyte. A claim is definite when those skilled in the art would understand what is claimed when the claim is read in light of the specification. *See, Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 1 U.S.P.Q.2d 1081, 1088 (Fed. Cir. 1986).

Amended claim 9 recites a self-referencing colorimetric resonant optical biosensor that comprises, *inter alia*, one or more specific binding substances immobilized on a first portion of the colorimetric resonant optical biosensor. In this form, a user can add, *e.g.*, a test sample comprising specific binding partners. The specific binding partners can bind the one or more specific binding substances immobilized on the

biosensor. One of skill in the art can then, *e.g.*, detect the binding of one or more specific binding substances to their respective binding partners.

Claim 13 recites a self-referencing colorimetric resonant optical biosensor that comprises, *inter alia*, one or more specific binding substances immobilized on a first portion of the colorimetric resonant optical biosensor and wherein the one or more specific binding substances are bound to their specific binding partners. This situation would occur, for example, after the user applied, *e.g.*, a test sample comprising specific binding partners to the biosensor, *but prior to detection* of the binding of one or more specific binding substances to their respective binding partners. The biosensor of claim 13 has utility because it can be, for example, scanned for detection of binding of the one or more specific binding substances to their specific binding partners. As such, the claim is definite and has utility. Applicants respectfully request withdrawal of the rejection.

**Rejection of Claims 9, 11, 12, and 14 Under 35 U.S.C. §103(a)**

Claims 9, 11, 12, and 14 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over U.S. Pat. No. 5,738,825 (the '825 patent) in view of U.S. Pat. No. 4,992,385 (the '385 patent). Applicants respectfully traverse the rejection.

The Office Action states that claim 10 stands as objected to as being dependant upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim. Applicant believes that claim 9 is patentable as written; however, in order to advance prosecution, the limitations of claim 10 have been incorporated into claim 9. Therefore, claims 9, 11, 12 and 14 are not obvious in view of the '825 patent and the '385 patent. Applicants respectfully request withdrawal of the rejection.

**Request for Rejoinder**

If claims 9, 11-14 are found to be allowable, then applicants respectfully request the rejoinder of claims 18, 20, and 22. Claims 18, 20, and 22 are process claims that incorporate all the limitations of product claim 9.

**Conclusion**

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to telephone Applicant's attorney to facilitate prosecution of this application.

Respectfully submitted,

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